

### **REMARKS – General**

#### **Claim Amendments:**

Claim 11 has been canceled.

Claim 12 has been amended to recite “...wherein the mobile radio device is configured to permit a user of the mobile radio device to send a message to the host system to access a different one of the plurality of email accounts by causing the host computer to correlate the radio device address with another of the plurality of email accounts.” Support for this amendment is found in the specification, as published, at paragraph [039].

Claim 12 has further been amended to recite correlation of radio device addresses with email identifiers on a one-to-one basis. Support for this amendment is found in the specification, as published, at paragraphs [021]-[022]. Claims 19 and 23 have been amended accordingly.

#### **Claim Rejections under 35 USC §101:**

Claims 14 and 19-22 are rejected under 35 USC §101 as being directed towards non-statutory subject matter.

With respect to claim 11, the Office Action (OA) submits that claim 11 is directed to a computer comprising only an interface. The Examiner interprets the interface to be software, which the OA submits is *per se* non-statutory. Claim 11 has been canceled.

With respect to claim 19, the OA submits that the claim is directed to a host computer comprising only an account table and a command message receiver. The Examiner interprets these elements to be portions of the virtual client software, which the OA submits is non-statutory.

In response, Applicant respectfully traverses the rejection, submitting that the claims recite elements tied to an apparatus, i.e., the computer. As the elements of each claim are tied to an apparatus, Applicant respectfully submits that the claims do indeed recite statutory subject matter as set forth below.

Prior to responding to the rejection, Applicant respectfully notes that the OA sets forth no rule, statute, or precedent in rejecting these claims as being non-statutory subject

matter. As the Examiner refers to software, Applicant presumes that the Examiner is referencing MPEP §2106.01, which is entitled “Computer Related Non-Statutory Subject Matter.” Applicant proceeds with its traversal to the rejection with this understanding. If the Examiner is instead citing another rule or precedent, Applicant respectfully requests clarification of the rejection.

Turning now to the rejection, according to MPEP §2106.01, “Descriptive material can be characterized as either ‘functional descriptive material’ or ‘nonfunctional descriptive material.’” MPEP §2106.01 continues, stating, “In this context, ‘functional descriptive material’ consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of ‘data structure’ is ‘a physical or logical relationship among data elements, designed to support specific data manipulation functions.’ ... ‘Nonfunctional descriptive material’ includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

MPEP §2106.01 then sets forth the conditions where functional descriptive material, e.g., software claimed as software alone, is non-statutory, stating, “Both types of ‘descriptive material’ are nonstatutory when claimed as descriptive material per se, [Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473,] 1360, 31 USPQ2d at 1759.” Emphasis added.

However, MPEP §2106.01 then sets forth the conditions with which functional descriptive material is statutory, stating, “When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *In re Warmerdam*, 33 F.3d 1354, 1360-61, 31 USPQ2d 1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).” Emphasis added.

Applicant respectfully submits that Applicant's claim 19 falls exactly within the guidelines set forth in MPEP §2106.01 for statutorily patentable subject matter in that each claim recites a computer comprising various elements. As is known in the art, computers are only capable of executing instructions recorded in computer readable media. As such, Applicant's recitation of a computer comprising various elements structurally and functionally interrelates the elements to the apparatus, thereby rendering the claim statutorily patentable subject matter. Applicant respectfully requests reconsideration of the rejection in light of these comments.

Claim Rejections under 35 USC §102:

Claims 11-13, 15, 16, 19, 20, and 22-24 are rejected under 35 USC §102(b) as being anticipated by an article entitled "Trials of Wireless, Secure Electronic Mail," by David R. Smith, Susan D. Simon, and Lawrence E. Cautilli, which will be referred to hereinafter as "Smith." The reasons for the rejection are set forth in the OA, and will not be repeated here in the interest of brevity. Applicant respectfully traverses the rejection.

In making the traversal, Applicant relies upon MPEP §2131, which states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The claimed elements must be inherent or expressly described in the reference. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988); *Verdegaal Brothers, supra*.

It is clear that for anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by one of ordinary skill in the art to which the invention pertains. *See, e.g., Scripps Clinic & Res. Found. V. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). Said differently, a single prior art reference must properly disclose, teach, or suggest each element of the claimed invention. Moreover, "every element of the claimed invention must literally be present, arranged as in the claim...The identical invention must be shown in as complete detail as is contained in the patent claim." *See, e.g., Richardson v. Suzuki Motor Company Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

With respect to claim 12, Applicant respectfully submits that Smith fails to teach a system wherein e-mail accounts are correlated with identifiers of a mobile device in an account table on a one-to-one basis, as is set forth in amended claim 12. Further, Applicant respectfully submits that Smith fails to teach and adjustment of the correlation in response to a command, the adjustment being made on a one-to-one basis. To the contrary, Smith at page 32, col. 2, lines 4-17 states that multiple users can use the same device, thereby indicating that there is no relationship between one mobile device address and one e-mail account. Even at page 32, col. 1, lines 29-34, where Smith states that user information is entered into e-mail software, there is no mention of an account table comprising a one-to-one correlation of a device address and the address of an e-mail account.

As Smith fails to teach the elements of Applicant's amended claim 12, with every element of the claimed invention being literally present, arranged as in the claim, and in as complete detail as is contained in the patent claim as required by MPEP §2131, Applicant respectfully submits that the rejection is overcome. Applicant respectfully requests reconsideration of the rejection to claim 12 and claims depending therefrom in light of the amendment and these comments. As claims 19 and 23 have been likewise amended, Applicant accordingly respectfully requests reconsideration of the rejections to claims 19 and 23, as well as claims depending therefrom, in light of these comments.

*Claim Rejections under 35 USC §103:*

Claims 14 and 21 are rejected as being unpatentable over Smith in view of an article entitled "A White Paper on Electronic Mail and Business-to-Business Communications" by Fabrik Communications, hereinafter referred to as "Fabrik." Applicant respectfully traverses this rejection, as the combination of Smith and Fabrik fails to teach Applicant's invention as recited in claims 12 and 19, from which claims 14 and 21 depend.

In the comments above, Applicant has shown that Smith fails to disclose, teach, or suggest an account table having a one-to-one correlation of mobile device identifiers with email accounts, combined with the ability to change this one-to-one correlation. The addition of Fabrik fails to correct this deficiency. Fabrik, at the penultimate page, states

that its solution “bypasses” establishing connections between devices and email services. As the combination of Smith and Fabrik fails to teach Applicant’s invention as set forth in claims 12 and 19, from which claims 14 and 21 depend, Applicant respectfully submits that claims 14 and 21 are allowable over the combination of Smith and Fabrik. Applicant respectfully requests reconsideration of the rejection in light of these comments.

**CONCLUSION**

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Burrus', written over the typed name.

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